

REMARKS

Reconsideration of the instant application is respectfully requested. The present amendment is responsive to the Final Office Action of August 24, 2006, in which claims 7-12 are presently pending. Each of claims 7-12 is now rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement as more specifically set forth on pages 2-3, paragraph 3 of the Office Action. Claims 7-8 are also rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention, as more specifically set forth on pages 3-4, paragraph 5 of the Office Action. Finally, claims 7-12 are rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter as more specifically set forth on pages 4-6 of the Final Office Action. For the following reasons, however, it respectfully submitted that the application is now in condition for allowance.

Rejections under 35 U.S.C. §112, first paragraph

The Examiner takes the position that the term “said customer value proposition” lacks enablement for the reason that it is a subjective value based on one’s perception of a customer’s needs. According to the Examiner, this therefore results in the claimed determination of a best fit location “not being repeatable,” and thus one skilled in the art would lack the ability to recreate the invention based on the disclosure as written. However, Applicants respectfully traverse the §112, first paragraph rejections.

MPEP 2164.03 provides in pertinent part:

The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The “amount of guidance or direction” refers to that information in the application, as originally filed,

that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. See, e.g., *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004) (“Nascent technology, however, must be enabled with a ‘specific and useful teaching.’ The law requires an enabling disclosure for nascent technology because a person of ordinary skill in the art has little or no knowledge independent from the patentee’s instruction. Thus, the public’s end of the bargain struck by the patent system is a full enabling disclosure of the claimed technology.” (citations omitted)).

The “predictability or lack thereof” in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the art provides evidence as to the question of predictability.

Regardless of the amount of knowledge existing in the art of information technology infrastructure, Applicants respectfully submit that the specification contains adequate detail as to how to determine the customer value proposition, which relates to a customer’s perceived value derived from information technology, in terms of cost and benefit. (Specification, page 5, lines 13-22) The Examiner correctly notes that page 9 of the specification provides an example of how the customer value proposition may be identified; e.g., through a series of structured interviews and workshops within the customer/end user population.

However, it is unclear to the Applicants as to how the claimed invention allegedly cannot be recreated by one skilled in the art. In other words, the Applicants are unable to tell from the Office Action whether it is alleged by the Examiner that: (1) the results (best fit location) obtained by user “A” of the claimed methodology/computer program product upon identifying a customer value proposition from customer “C” would vary from the results obtained by another user “B” upon performing the same steps in identifying a customer value proposition from the same customer C; or (2) the results obtained by user A for customer C would vary with respect to the results obtained by user A for another customer “D.”

With respect to the latter, it should be expected that different customers would place different cost/benefit values on information technology, depending on the nature of the organization. Applicants therefore presume the Examiner is referring to the first instance; i.e., the Examiner alleges that different users of the invention would obtain different results as applied to the same customer.

Although a customer’s views on the cost/benefit value of information technology are inherently subjective in nature, a user’s determination of this view from interaction with the customer is not. The Examiner states that the customer value proposition is based on “one’s perception” of the customer’s needs. Applicants respectfully submit that this is not the case; rather, the specification teaches that customer value proposition is accomplished through structured interviews and workshops, as opposed mere guesswork and user perceptions. As such (presuming a given customer consistently and truthfully responds to each skilled user of the invention), the results obtained would be consistent. Consequently, the resulting best fit location in the matrix would be consistent from user to user.

Accordingly, because one skilled in the art would be able to recreate the invention by obtaining a substantially consistent customer value proposition, claims 7-12 are

enabled by the written description in the specification, and it is respectfully submitted that the §112, first paragraph rejections have been overcome.

Rejections under 35 U.S.C. §112, second paragraph

Turning next to the §112, second paragraph rejections, the Examiner takes the position that the recitation “locating a customer value proposition within said matrix, said customer value proposition comprising a user input indicative of value derived from the use of IT services” is vague and indefinite. As indicated on page 10 of the specification, the customer value propositions are characterized based on the resulting degree of centralization and consolidation to be applied to the infrastructure, and located into the appropriate quadrant in the matrix as illustrated in Figures 3-5. Figure 4 already illustrates exemplary customer value propositions along the vertical (consolidation) and horizontal (centralization) axes of the matrix 40. The customer value proposition is not the specific objective, but rather is used to obtain the specific objective; i.e., a best fit location within the matrix, which in turn corresponds to a degree of centralization and consolidation to be implemented for the IT infrastructure.

Moreover, Applicants further point out that amended claim 8 specifically recites how the customer value proposition is located within the matrix (by determining a relationship profile for the organizational entity). It is noted that the present amendment also addresses and corrects the antecedent basis issue with claim 8.

Because the amended claims now more particularly point out a clear and concise meaning of the terms, it is respectfully submitted that each of the outstanding §112, second paragraph rejections have now been overcome.

Rejections under 35 U.S.C. §101

Finally, with regard to the §101 non-statutory subject matter rejections, the Examiner takes the position that the claims appear to be directed to nothing more than determining a position on a matrix without any concrete and tangible result and are

therefore deemed to be non-statutory. Applicants respectfully traverse. In the first place, the identification of a customer proposition value is an intermediate step in the claimed process and thus it is irrelevant as to whether it is deemed to be a tangible result in and of itself. Secondly, and as stated above, the customer value proposition itself is not a subjective value (although based on a customer's subjective input) and can be ascertained by one skilled in the art. Given that the customer value proposition is ascertainable, its position in the matrix is also ascertainable, as is the best fit location of a plurality of customer value propositions. As to the Examiner's statement that the result (location on the matrix) fails to use the output to determine what tangible and concrete actions a user needs to carry out, the Applicants respectfully submit that the claim language "wherein said best fit location in said matrix corresponds to a degree of centralization and consolidation to be implemented for the IT infrastructure" defines a useful result. That is, the result provides direction for a designer of an IT infrastructure in the design and implementation of the infrastructure.

The design of an IT infrastructure is a tangible and practical endeavor. Therefore, any tool that assists a designer in the task of designing/implementing the infrastructure is also useful. The factors in ultimately determining a degree of centralization/consolidation (which assists the designer) are well defined in the specification and claims as stated above. Accordingly, the Applicants respectfully submit that the §101 rejections have been overcome.

For the above stated reasons, it is respectfully submitted that the present application is now in condition for allowance. No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 09-0458 maintained by Applicants' attorneys.

Respectfully submitted,
LESLIE MARK ERNEST, ET AL.

CANTOR COLBURN LLP
Applicants' Attorneys

By /Sean F. Sullivan/
Sean F. Sullivan
Registration No. 38,328
Customer No. 29371

Date: November 22, 2006
Address: 55 Griffin Road South, Bloomfield, CT 06002
Telephone: (860) 286-2929